UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/702,094	11/05/2003	Robert P. Madill JR.	5053-64100	6815

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EXAMINER
WINTER, JOHN M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _27 May 2008_.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _66,67, 69- 70, 73- 78, 79-82, 134 and 159-167_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _66,67, 69- 70, 73- 78, 79-82, 134 and 159-167_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The Applicants amendment filed on January 5, 2009 is hereby acknowledged, Claims 66,67, 69- 70, 73- 78, 79-82, 134 and 159-167 remain pending .

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 5, 2009 has been entered.

Response to Arguments

3. The Examiner states based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

4. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

5. To meet prong (1), the method step should positively recite the other statutory class
    (the thing or product) to which it is tied.   This may be accomplished by having the
    claim positively recite the machine that accomplishes the method steps. Alternatively
    or to meet prong (2), the method step should positively recite identifying the material
    that is being changed to a different state or positively recite the subject matter that is
    being transformed.

6. In this particular case, claim 66 fails prong (1) because the "tie" (e.g. a computer
    system) is representative of extra-solution activity.

7. The Applicant states that Torres or Pendleton Jr. does not appear to teach or suggest
    determining a weighted, combined fraud potential indicator for the request
    corresponding to the particular accident, financial transaction, or medical bill, wherein
    the weighted-combined fraud potential indicator for the request corresponding to the
    particular accident, financial transaction, or medical bill, as recited by claim 66.

    The Examiner replies that this feature is disclosed by Pendleton, Jr.; the reference
    states "In other words, the fraud indicators stored in memory 62 for each claim line
    analyzed for a particular provider are summed and divided by the total number of
    claim lines. This approach represents one of several which may be used. Other
    approaches include **computing a weighted average** of the individual fraud indicators,
    or selecting a subset of the indicators for use in computing the composite fraud
    indicator. After the composite fraud indicator is computed, it is compared to a
    threshold number which is based upon prior experience (block 70)" (column 7, lines
    35-59)

8. The Applicant states that Claim 66 describes a combination of features including:

"wherein the first fraud potential detection technique is different from the second fraud

potential detection technique." The combination of cited art does not appear to teach or

suggest at least the above quoted feature, in combination with the other features of

claim 66.

The Examiner responds that Torres states "The method may further comprise

enabling the investigator to select an analytic function for determining a comparative

analytical score of a selected transaction dataset, the analytic function selected from

the group consisting of a similarity search function, a biometric function, a rules

engine, a neural net, a model engine, an auto link analysis, a decision tree, and a report

engine." (paragraph 21) The Examiner submits the different analytic functions

discloses by Torres are analogous to the claimed feature of "the first fraud potential

detection technique is different from the second fraud potential detection technique."

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 66,67, 69- 70, 73-75, 79-82, 134 and 159-167 are rejected under 35 U.S.C. 101

because the claimed invention is directed to non-statutory subject matter. Based on

Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981);

Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70

(1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit

decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. <u>In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).</u>

11. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

12. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied.   This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

13. In this particular case, claim 66 fails prong (1) <u>because the "tie" (e.g. a computer system) is representative of extra-solution activity</u>. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

14. Claims 67, 69- 70, 73-5, 79-82, 134 and 159-167 contains similar limitations or are dependant upon claim 66 and are rejected for at least the same reasons.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth
> in section 102 of this title, if the differences between the subject matter sought to be patented and the
> prior art are such that the subject matter as a whole would have been obvious at the time the invention
> was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability
> shall not be negatived by the manner in which the invention was made.

16. Claims 66,67, 69- 70, 73- 78, 79-82, 134 and 159-167 are rejected under 35 U.S.C.

103(a) as being unpatentable over Torres et al., (US Patent Application No

2005/0043961) and further in view of Pendleton, Jr. (US Patent 6,253,186), and further

in view of Suresh et al. (US Patent 7,263,492)

17. As per claim 66,
Torres et al. ('961) discloses a method of assessing fraud potential using a computer

system, comprising:

retrieving request data from a memory of the computer system;

providing at least two fraud potential indicators for a request (paragraph 21)

wherein a first fraud potential indicator for the request is assessed using a first fraud

potential detection technique and a second fraud potential indicator for the request is

assessed using a second fraud potential detection technique, wherein the first fraud

potential detection technique is different from the second fraud potential detection

technique; and wherein at least one of the assessment using the first fraud potential

detection technique and the assessment using second fraud potential detection

technique is based at least in part on the request data retrieved from the memory of the

computer system;

(paragraph 23)

18. displaying a score or rank for at least the first and second fraud potential indicators in a graphical user interface.(Figure 7)

19. determining a weighted, combined fraud potential indicator for the request (Paragraphs 22 and 43)

20. Torres et al. ('961) does not explicitly disclose wherein the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill combines at least the first fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill assessed using the first fraud technique and the second fraud potential indicator assessed for the request corresponding to the particular accident, financial transaction, or medical bill using the second fraud technique, wherein, in combining the first fraud potential indicator and the second fraud potential indicator, the first fraud potential indicator is weighted differently from the second fraud potential indicator; and referring the request corresponding to the particular accident, financial transaction, or medical bill for review if the weighted, combined fraud potential indicator for the request corresponding to the particular accident, financial transaction, or medical bill exceeds a threshold value, wherein the threshold value is adjusted to control the number of requests with the weighted, combined fraud potential indicator exceeding the threshold value.. Pendleton, Jr. ('186) discloses wherein the weighted, combined fraud potential indicator for the request corresponding to the particular accident,

financial transaction, or medical bill combines at least the first fraud potential indicator

for the request corresponding to the particular accident, financial transaction, or

medical bill assessed using the first fraud technique and the second fraud potential

indicator assessed for the request corresponding to the particular accident, financial

transaction, or medical bill using the second fraud technique, wherein, in combining

the first fraud potential indicator and the second fraud potential indicator, the first

fraud potential indicator is weighted differently from the second fraud potential

indicator; and referring the request corresponding to the particular accident, financial

transaction, or medical bill for review if the weighted, combined fraud potential

indicator for the request corresponding to the particular accident, financial transaction,

or medical bill exceeds a threshold value, wherein the threshold value is adjusted to

control the number of requests with the weighted, combined fraud potential indicator

exceeding the threshold value. (column 7, lines 35-59 -- Applicant(s) are reminded

that optional or conditional elements do not narrow the claims because they can always

be omitted. See e.g. MPEP §2106 II C: "Language that suggest or makes optional but

does not require steps to be performed or does not limit a claim to a particular structure

does not limit the scope of a claim or claim limitation. [Emphasis in original.] " As a

matter of linguistic precision, optional elements do not narrow the claim because they

can always be omitted.) It would be obvious to one having ordinary skill in the art at

the time of the invention to combine Torres et al. ('961)'s method with Pendleton, Jr.

('186)'s teaching in order to determine the rate of increase of fraudulent claims;

furthermore the combination of these elements does not alter their respective functions,

and the combination would have yielded predictable results to one of ordinary skill in

the art at the time of the invention..

Torres et al. ('961) does not explicitly disclose a request to a financial institution

relating to a particular accident, a particular financial transaction, or a particular

medical bill. Suresh et al. ('492)discloses a request to a financial institution relating to

a particular accident, a particular financial transaction, or a particular medical bill.

(Discussion of claim data, beginning on column 6, line 64) It would be obvious to one

having ordinary skill in the art at the time of the invention to combine Torres et al.

('961)'s method with Suresh et al. ('492)'s teaching in order to only process claims

relevant to a specific dispute.

21. Claims 76, 80, 134 and 162 are not patentably distinct from claim 66 and are rejected

for at least the same reasons.

22.   As per claim 67,

Torres et al. ('961) discloses the method of claim 66,

wherein clicking on at least one fraud potential indicator for the at least one request

will display information about the at least one request. (paragraph 47, figure 7)

23. As per claim 69,

Torres et al. ('961) discloses the method of claim 66, further comprising

wherein at least one request is an insurance claim, and at least one insurance

claim is organized into lists according to at least two of referred claims, assigned

claims, or rejected claims, and wherein selecting a graphical component respective to

at least one of a referred claims, desired claims, or rejected claims brings up a list of

claims in the corresponding list.(Figures 9 and 7)

24. As per claim 70,

25. Torres et al. ('961) discloses the method of claim 66, further comprising

26. further comprising changing a criteria about which claims to display by selecting a

filter graphical component. (Figure 8)

27. As per claim 71,

Torres et al. ('961) discloses the method of claim 66, further comprising

assigning at least one request by selecting an desired graphical component. (Figure 7)

28. As per claim 72,

Torres et al. ('961) discloses the method of claim 66, further comprising

rejecting at least one request by selecting a reject graphical component.(Figure 1)

29. As per claim 73,

Torres et al. ('961) discloses the method of claim 66,

wherein at least one gaud potential detection technique comprises predictive

modeling.(Paragraph 21)

30. Claims 77 and 81 are in parallel with claim 73 and are rejected for at least the same reasons.

31. As per claim 74,

Torres et al. ('961) discloses the method of claim 66,

Official Notice is taken that "at least one fraud potential detection technique comprises at least one identity search of insurance claim data" is common and well known in prior art in reference to fraud detection protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an identity search in order to expose any aliases that the claim filer may have used in the past.

32. Claims 78 and 82 are in parallel with claim 74 and are rejected for at least the same reasons.

33. As per claim 75,

34. Torres et al. ('961) discloses the method of claim 66,

35. wherein at least one fraud potential detection technique comprises assessing request data using at least one business rule(Paragraph 21).

36. Claims 79 and 83 are in parallel with claim 75 and are rejected for at least the same reasons.

37. As per claim 159,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud

potential indicators is a predictive modeling engine, and wherein displaying the score

or rank for the first and second fraud potential indicator comprises displaying

information on at least one match used by the business rules engine to assign the fraud

potential indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential

indicators", It would have been obvious to one having ordinary skill in the art at the

time the invention was made to use two fraud potential indicators, since it has been

held that mere duplication of the essential working parts of a device involves only

routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

38. As per claim 160,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud

potential indicators is a identity search engine, and wherein displaying the score or

rank for the first and second fraud potential indicator comprises displaying information

on at least one match used by the business rules engine to assign the fraud potential

indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential

indicators", It would have been obvious to one having ordinary skill in the art at the

time the invention was made to use two fraud potential indicators, since it has been

held that mere duplication of the essential working parts of a device involves only

routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

39. As per claim 161,

Torres et al. ('961) discloses the method of claim 134,

wherein at least one engine used to assign at least one of the first or second fraud

potential indicators is a business rule engine, and wherein displaying the score or rank

for the first and second fraud potential indicator comprises displaying information on

at least one match used by the business rules engine to assign the fraud potential

indicator based on the business rule engine.. (Figures 7 and 8)

Torres et al. discloses the claimed invention except for "two fraud potential

indicators", It would have been obvious to one having ordinary skill in the art at the

time the invention was made to use two fraud potential indicators, since it has been

held that mere duplication of the essential working parts of a device involves only

routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

40. Claim 163 is parallel with claim 161 and is rejected for at least the same reasons.

41. Claims 164-167 are not patentably distinct from the above rejected claims and are

rejected for at least the same reasons.

Conclusion

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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